

### REMARKS

1. Claims 1, 4, 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 8 and 11 have been amended to eliminate the recited deficiencies. No new matter is added.

2. Claims 1, 4, 6, 7, 8, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 321,920 to Wunderlick in view of US Patent No. 4,113,107 to Jaeger.

Applicant respectfully submits that the Examiner has failed to establish a prima facie case for obviousness in rejecting claims 1, 4, 6, 7, 8, 11, and 14.

Three basic criteria must be satisfied before a prima facie case for obviousness can be established.

- a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings of two or more references.
- b) Second, there must be a reasonable expectation of success.
- c) Finally, the prior art references, when combined, must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. MPEP, 7<sup>th</sup> ed. Revision 1, February 2000, § 706.02(j) citing *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

There is No Motivation to Combine the Cited References.

There is no motivation for combining the teachings of Wunderlick and Fischer and in fact the Fischer reference teaches away from such a combination. The nature of the problem sought to be solved by Wunderlick was to provide a "portable gun or musket rack and a combined gun and clothes rack." Wunderlick, col. 1 lines 16 –18, arranged and constructed in such a manner that supporting arms may be swiveled, whereas the problem sought to be solved by Fischer was how to secure a firearm to a wall or other fixed structure in a way that permits maximum security. Accordingly, Fischer teaches, "Referring to FIGS. 1 and 2, a firearm safety guard 10 embodying the principles of this invention is mounted in the corner formed by walls 12 and 14. Safety guard 10 contains a shotgun 16 with trigger guard 16a shown in phantom. It is understood that safety guard 10 need not be mounted in corner although that is preferred for maximum security." Fischer, col. 2, Ins. 42 –48.

The nature of the problem sought to be solved by the present invention is securing a firearm in a device that allows the firearm to be both secured to the rack while still being pivotable. Motivation to combine the gun rack of Wunderlick, which allows for pivotable movement of the firearm with the pivotable movement of the rack itself, with the rigid maximum security offered by Fischer is nonexistent and such a combination would defeat the objectives of each invention rendering either inoperable.

In *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the Federal Circuit addressed the need for a specific finding of motivation to combine references to support an obviousness rejection. The court reversed the Board's rejections of claims as obvious under 35 U.S.C. § 103 and for double patenting. The claims were directed to a large trash bag made of orange plastic decorated with lines and facial that, when the bag is filled with trash or leaves, it resembles a jack-

o'-lantern. The prior art included conventional plastic leaf trash bags and two arts and crafts books describing jack-o'-lanterns made out of small paper bags or crepe paper. Even though the Board described in detail the similarities between the prior art and the claimed invention, the court found lack of motivation to combine the references, noting that the Board failed to particularly identify any suggestion, teaching, or motivation to combine the children's art references with the conventional trash or lawn bags.

In *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, Fed.Cir. (2001), the patent related to a instructional pitching device in the form of a regulation baseball with specific "finger placement indicia" for teaching students how to grasp a baseball, the Federal Circuit reversed a District of Kansas finding of invalidity. The Court warned that the rule on whether the combined references for motivational purposes must be applied rigorously where the art in question is relatively simple as here, creates the opportunity to judge by hindsight, which was particularly tempting.

In the present application, Applicant's claimed invention has simply been employed as a blueprint and the rejection is based on hindsight prompted by Applicant's claim rather than motivation found in the cited references.

The Court in *McGinley v. Franklin Sports, Inc.*, *supra*, affirmed the concept that if the references taken in combination would produce a seemingly inoperative device, such references teach away from the combination and thus cannot serve as a predicate for a prima facie case of obviousness.

Such is the case in the present application. The Examiner's suggestion that there is motivation for combining the teachings of Wunderlick and Fischer is negated by the fact that the resulting combination would result in an inoperative device. Combining the portable and pivotable features of Wunderlick with firearm support of Fischer negates the rigid "maximum security" objective of Fischer. Similarly, combining the rigid "maximum security" structure offered by Fischer would negate the portable and pivotable features of Wunderlick.

The cited prior art as a whole must "suggest the desirability" of the combination. *In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992) (internal quotation omitted); *Winner Int'l Royalty Corp. v. Wang*, 202F.3d 1340 (Fed. Cir. 2000). Such is not the case with the references cited by the Examiner in support of the current rejection.

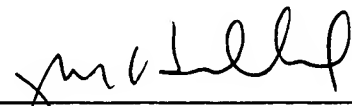
Applicant respectfully submits that the rejection of Claims 1, 4, 6, 7, 8, 11, and 14 under 35 U.S.C. 103(a) as being unpatentable over Wunderlick in view of Fischer should be withdrawn and that the claims should be allowed.

3. Applicant believes the application is in condition for allowance and respectfully requests the same. If the Examiner is of a differing opinion he/she is hereby requested to conduct a telephonic interview with the undersigned attorney.

Respectfully submitted.

HOLLAND LAW OFFICE, PLLC

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